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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,371	01/23/2004	Arnold Stan Lippa	10596-018-999	9973
20583	7590	01/23/2006	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			SOLOLA, TAOFIQ A	
			ART UNIT	PAPER NUMBER
			1626	
DATE MAILED: 01/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/764,371

**Applicant(s)**

LIPPA ET AL.

**Examiner**

Taofiq A. Solola

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 45-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 45-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

Art Unit: 1626

Claims 45-48 are pending in this application.

Claims 1-44, 49-56 are canceled.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beer et al., US 6,204,284 B1.

Applicant claims a method of using the instant compound, in its (-) isomeric form substantially free of the corresponding enantiomers, for treating specific addictive disorders.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Beer et al., teach a method of using the racemic mixture of the instant compound for treating addictive disorder.<sup>5</sup> See column 2, lines 24-26.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between the instant invention and that of Beer et al., is that applicant uses the (-) isomer substantially free of the corresponding (+) isomer instead of racemic mixture by Beer et al. Also, applicant claims treatment of specific addictive disorders instead of generic addictive disorders by Beer et al.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142.2413)*

The term "addictive disorders" embraces specific addictive disorders. The racemic mixture of Beer et al., include the (-) isomer and the phraseology "substantially free" implies the instant compound is not 100 % (-) isomers: "contains no more than 5 % w/w the . . . (+) isomer."

Art Unit: 1626

The compound of Beer et al., and the instant compound have both isomers except in degrees. Therefore, the instant invention is prima facie obvious from the teaching of Beer et al. One of ordinary skill in the art would have known to use the (-) isomer at the time the invention was made. The motivation is from a well-established principle that an isomer is often more reactive than the corresponding isomer or the racemate. *In re Adamson*, 125 USPQ 233 (1960). Therefore, one of ordinary skill in the art wanting to know the more active isomer would have separated the isomers. Also, the selection of an isomer among its racemic mixture is prima facie obvious. *In re Lemin*, 141 USPQ 814 (1964).

Applicant's arguments filed 11/16/05 have been fully considered but they are not persuasive. Applicant contends that since the instant compound was allowed in the parent case, methods of using it are allowable. This is generally true but not persuasive because the Office is not in the business of perpetuating its error. Applicant further argues that the instant isomer shows unexpected result vis-à-vis the racemate. This is not persuasive because an isomer is expected to be more active than the racemate or the other isomer. Therefore, applicant's finding is not unexpected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1626

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

  
**TAOFIQ SOLOLA**  
**PRIMARY EXAMINER**  
Group 1626

January 18, 2006